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10/715,313	11/17/2003	Keith A. Thuerk	BOC9-2003-0033 (402)	5100
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EXAMINER				
GOODCHILD, WILLIAM J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,313

Applicant(s)

THUERK, KEITH A.

Examiner

WILLIAM J. GOODCHILD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The use of the trademark Lotus Sametime has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

Claims 2, 15, 20 and 33 contains the trademark/trade name Lotus Sametime. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the Lotus Sametime product as a type of system and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 34-35 are directed to a "system" but fail to recite any hardware elements in the claim, wherein the "means" instance of the claim are depicted as software per se, which renders the claim solely as a software implementation and non-statutory for failing to satisfy a statutory category. In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

An example of an acceptable limitation would be "a computer configured to run an instant messaging client" or "means for specifying at least one search limitation within a search GUI configured to run on a computer system" or similar wording that explicitly includes a piece of hardware being an active part of the claim limitations.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 6-20 and 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landon et al., "Deploying Lotus Sametime on the eServer iSeries Server", Redbooks, June 2002, (hereinafter Landon), and further in view of Pabla et al., (US Publication No. 2004/0064693), (hereinafter Pabla).

Regarding claims 1, 19 and 34 Landon discloses providing a collaborative computing system comprising at least one instant messaging client [Landon, page 2, 1.1, page 65, figure 3-46, Sametime Connect for the desktop, Exchange messages with AOL Instant Messenger users], the collaborative computing system including presence awareness features that automatically detect online entities that are logged into the collaborative computing system [Landon, page 9, 1.3.3, Sametime Connect client, 4th paragraph, 'Both versions of the Sametime Connect client contain a presence list or buddy list that provides an entry point to all collaborative activities in Sametime. This buddy list can display the name of any user in the Sametime community that is online']; initializing said instant message client within a graphical user interface of said collaborative computing system [Landon, page 136, 5.2.1];

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specifying at least one search limitation, [Landon, page 201, Creating a buddy list and group] said search limitation preventing users other than user belonging to a predetermined class of users from accessing data records pertaining to one or more predetermined online entities and from receiving data indicating an online presence of one or more predetermined online entities [Landon, page 6, 1.2.9, Security, access is restricted via Access control lists for users or groups access to a database]; receiving a search initializing action from said graphical user interface [Landon, page 201, Creating a buddy list and group]; responsive to said receiving step, presenting search input fields within said graphical user interface [Landon, page 201, figure 6-7]; receiving input via said input fields that specifies a search pattern [Landon, page 201, figure 6-7 and Creating a buddy list and group]; displaying a search result from said searching step within said graphical user interface [Landon, page 201, step 2]; selecting at least one of the online entities displayed in the search result [Landon, page 9, 1.3.3, Sametime Connect client, 4th paragraph, 'Both versions of the Sametime Connect client contain a presence list or buddy list that provides an entry point to all collaborative activities in Sametime. This buddy list can display the name of any user in the Sametime community that is online', page 136, 5.2.1, Sametime Connect for the desktop and 5.2.2, Sametime Connect for Web browsers]; establishing a software-enhanced communication not limited to instant messaging between a user of the instant messaging client and the selected online entity [Landon,

page 9, 1.3.3, Sametime Connect client, 4th paragraph, 'Both versions of the Sametime Connect client contain a presence list or buddy list that provides an entry point to all collaborative activities in Sametime. This buddy list can display the name of any user in the Sametime community that is online', page 136, 5.2.1, Sametime Connect for the desktop and 5.2.2, Sametime Connect for Web browsers].

Landon does not specifically disclose subject to said at least one search limitation, searching at least one record source for online entities that satisfy said search pattern using the presence awareness features. However, Pabla in the same field of endeavor discloses search or query the instant messaging distributed index of presence information to discover the presence of other participating peers [Pabla, paragraphs 114 and 139]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate searching a large list of presence users in a communication environment in order to efficiently locate a user or group of users pertaining to the searchers requirements.

Regarding claims 2 and 20, Landon further discloses said collaborative computing system is a Lotus Sametime (TM) type system [Landon, page 15].

Regarding claims 6 and 24, Landon further discloses establishing a plurality of user specific search patterns; and recording said search patterns so that said search

patterns can be retrieved at a later time [Landon, page 126, 1st paragraph and figure 4-22, Search filters].

Regarding claims 7 and 25, Landon further discloses said record source comprises a first database that is a record source specifying at least one online entity and a second database having a data field, wherein said data field specifies an attribute relating to said online entity that is not specified within said first database, said searching step further comprising the steps of: establishing a query that includes said data field; and searching for at least one online entity using said query [Landon, page 126, figure 4-22, field search filter for resolving person or groups and table 4-5].

Regarding claims 8 and 26, Landon further discloses specifying a plurality of record sources, each of which specifies at least one online entity, wherein said searching step further comprises searching said plurality of record sources for online entities that satisfy said search pattern [Landon, page 120, table 4-2, Description of Field "Host Name or IP address of the LDAP server"].

Regarding claims 9 and 27, Landon further discloses establishing at least one search preference that is used when performing said searching step, wherein said search result is based at least in part upon said search preference [Landon, page 122, table 4-3, Field 'People'].

Regarding claims 10 and 28, Landon further discloses establishing an order in which said record sources are accessed during said searching step [Landon, page 120, table 4-2, Field "Position of this server in the search order"].

Regarding claims 11 and 29, Landon further discloses directly executing at least one software-enhanced communication involving said online entity and a user of said graphical user interface using said search result [Landon, page 9, 1.3.3, 4th and 5th paragraphs].

Regarding claims 12, 30 and 35, Landon-Pabla further discloses specifying at least one search limitation, [Landon, page 201, Creating a buddy list and group], said search limitation preventing users other than users belonging to a predetermined class of users from accessing data records pertaining to one or more predetermined online entities and from receiving data indicating an online presence of one or more predetermined online entities [Landon, page 6, 1.2.9, Security, access is restricted via Access control lists for users or groups access to a database]; receiving a user specified search pattern [Landon, page 125, #'s 11-12]; subject to said at least one search limitation, searching a point of presence database for online entities having access to a collaboration software application which satisfy said search pattern [Landon, page 3, 1.2.3, page 126, figure 4-22 and table 4-5], the collaborative software application including presence awareness features [Pabla, paragraphs 114 and 139] that automatically detect online entities that are logged into

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the collaborative computing system [Landon, page 9, 1.3.3, Sametime Connect client, 4th paragraph, 'Both versions of the Sametime Connect client contain a presence list or buddy list that provides an entry point to all collaborative activities in Sametime. This buddy list can display the name of any user in the Sametime community that is online']; presenting a list of said resulting online entities [Landon, page 126, 1st paragraph]; receiving a selection of at least one of said resulting online entities contained within said list [page 126, 1st paragraph]; and establishing a software-enhanced communication session not limited to instant messaging between said user and said selected online entity [Landon, page 9, 1.3.3, Sametime Connect client, 4th paragraph, 'Both versions of the Sametime Connect client contain a presence list or buddy list that provides an entry point to all collaborative activities in Sametime. This buddy list can display the name of any user in the Sametime community that is online', page 136, 5.2.1, Sametime Connect for the desktop and 5.2.2, Sametime Connect for Web browsers].

Regarding claims 13 and 31, Landon further discloses displaying a graphical user interface for an instant messaging component of said collaboration software application [Landon, page 151, figure 5-28], wherein said graphical user interface provides a user selectable search option; receiving a user selection for said search option [Landon, page 201]; and responsively presenting search input fields within said graphical user interface, wherein said search pattern is based upon data input into said search input fields [Landon, page 201, input box].

Regarding claims 14 and 32, Landon further discloses said software-enhanced communication session includes a type of communication other than instant messaging [Landon, page 150, 5.5 – page 151].

Regarding claims 15 and 33, Landon further discloses said collaboration software application is a Lotus Sametime (TM) type application [Landon, page 15].

Regarding claim 16, Landon-Pabla further discloses means for automatically detecting online entities that are logged into the collaborative computing system [Landon, page 9, 1.3.3 Sametime Connect client];

a collaboration server configured to coordinate collaboration operations between a plurality of geographically disperse software components [Landon, page 9, 1.3.3, 4th paragraph]; and at least one client side collaboration application that includes a search engine, said search engine configured to query said collaboration software system for online entities [Landon, page 121, figures 4-19 and 4-20], wherein said client side collaboration application contains a graphical user interface permitting user customization of said search engine [Landon, page 121, figures 4-19 and 4-20], and wherein said search engine is configured to specify at least one search limitation, said search limitation preventing users other than users belonging to a predetermined class of users from accessing data records pertaining to one or more predetermined online entities and from receiving data indicating an online presence of one or more

predetermined online entities [Landon, page 6, 1.2.9, Security, access is restricted via Access control lists for users or groups access to a database],
said graphical user interface displaying a search result and establishing a software-enhanced communication not limited to instant messaging between a user of the graphical user interface and an online entity selected from an online entity list displayed in the search result [Landon, page 9, 1.3.3, Sametime Connect client, 4th paragraph, 'Both versions of the Sametime Connect client contain a presence list or buddy list that provides an entry point to all collaborative activities in Sametime. This buddy list can display the name of any user in the Sametime community that is online', page 136, 5.2.1, Sametime Connect for the desktop and 5.2.2, Sametime Connect for Web browsers].

Regarding claim 17, Landon further discloses said graphical user interface comprises an instant messenger view and a search view [page 201, figure 6-7].

Regarding claim 18, Landon further discloses said search view is directly initiated from said instant messenger view, and wherein said search view utilizes said search engine [page 201, figure 6-7 and item 2].

5. Claims 3-5 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landon-Pabla as applied to claims 1 and 19 above, and further in view of Berger et al., (US Publication No. 2004/0267887), (hereinafter Berger).

Regarding claims 3 and 21, Landon-Pabla does not specifically disclose said search initializing action comprises at most two user inputs. However, Berger in the same field of endeavor, discloses an option for searching for 'additional contact options' [Berger, paragraph 33]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate search options with default settings in order to reduce the number of required entries by the user.

Regarding claims 4 and 22, Landon-Pabla-Berger further discloses displaying a menu option within said graphical user interface for said instant message client, wherein said menu option is configured to initiate said search view [Berger, paragraph 33].

Regarding claims 5 and 23, Landon-Pabla-Berger further discloses providing a keyboard combination to initiate said search view, whereby said keyboard combination is a hot-key combination [Berger, paragraph 35, 'or selecting a designated key from the data processing device's keyboard'].

Response to Arguments

6. Applicant's arguments filed 04/14/2008 have been fully considered but they are not persuasive.

A – Applicant argues “Applicants believe that the language of Claims 34 and 35 clearly indicates that they are not software per se; rather, they comprise different modules or means which can be implemented as hardware or a combination of hardware and software. For example, means for conducting a user specific search or for receiving a user specific search pattern is clearly a device. A software per se cannot receive any user input.”.

A – Claims 34-35 can be considered software per se, as the limitations do not specifically recite a piece of hardware within the limitation of the claims [not the pre-ambles] that is actively used within the limitations such as: “a computer configured to run an instant messaging client” or “means for specifying at least one search limitation within a search GUI configured to run on a computer system” or similar wording that explicitly includes a piece of hardware being an active part of the claim limitations. Regarding the example, ‘means for conducting a user specific search or for receiving a user specific search pattern is clearly a device. A software per se cannot receive any user input.’ could be considered software in that use input could be through a pre defined file.

7. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. GOODCHILD whose telephone number is (571)270-1589. The examiner can normally be reached on Monday - Friday / 8:00 AM - 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WJG

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145